

REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the amendments and remarks herewith, which place the application into condition for allowance. The present amendment is being made to facilitate prosecution of the application.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1-11 are currently pending. Claims 1, 4, 9 and 11 are independent. Claims 1, 4, 8, 9 and 11 are hereby amended. No new matter has been introduced. Support for this amendment is provided throughout the Specification as originally filed.

Changes to the claims are not made for the purpose of patentability within the meaning of 35 U.S.C. §101, §102, §103, or §112. Rather, these changes are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. REJECTIONS UNDER 35 U.S.C. §102

Claims 1-6, 9 and 10 were rejected under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Patent No. 6,701,528 to Arsenault et al. (hereinafter, merely Arsenault). Applicants respectfully traverse this rejection.

Independent claim 1, in its present form, recites, *inter alia*:

“a control means to execute control in which the forefront data from a selected channel is reproduced by the digital signal reproduction means when the program is selected and writes to the memory means the data following the forefront data from the selected channel simultaneously with reproduction of the forefront data, and after reproduction of the forefront data the following data is read from the memory means to be outputted continuously after the forefront data,

...

wherein a time information extract means extracting time information in the program is provided so that time information of a clock function corresponds to the time information of the information extract means, and when the program is altered, the data recorded in the record means is recorded over again onto the forefront data of the altered program, employing the time information obtained in the time information extract means as a standard.”

First, claim 1, as amended, recites, “forefront data from a selected channel is reproduced . . . and writes to the memory means the data following the forefront data from the selected channel simultaneously with reproduction of the forefront data, and after reproduction of the forefront data the following data is read from the memory means to be outputted continuously after the forefront data.” That is, data following the forefront data is written to the memory simultaneously with the reproduction of the forefront data. After the forefront data is reproduced, the following data is read from the memory for a continuous output.

An example is provided in the as-filed specification. Referring to FIGS, 2A-2B, while the forefront data (a to c) is reproduced, the channel in which data following the data c exists is selected (*e.g.*, channel 3) by the central processing unit 5 as shown in FIG. 2B, and the hard disk drive 14 writes the data following the data c simultaneously. After reproduction of the forefront data (a to c) recorded in advance on the VCR 1, the read data of the hard disk drive 14 is supplied to the buffer 8 via the switch 6 as shown in FIG. 2B so that a user can watch the following part of the data c. Thereafter, the hard disk drive 14 performs write operation and read operation in parallel, and the user can watch the movie by the data read out until the end b. Publ. App. par. [0036]-[0036]

Second, claim 1, as amended, recites, “extracting time information in the program is provided so that time information of a clock function corresponds to the time information of the information extract means, and when the program is altered, the data recorded in the record

means is recorded over again onto the forefront data of the altered program, employing the time information obtained in the time information extract means as a standard.”

That is, using the example in FIGS. 2A-2B, the broadcast signal is supplied to a time information extract circuit 40 extracting time information contained in the broadcast signal, and the time information obtained in the time information extract circuit 40 is supplied to the central processing unit 5 so that time information of a clock function that the central processing unit 5 has corresponds to the time information of the time information extract circuit 40.

The elements discussed above are not disclosed in Arsenault. Thus, claim 1 is patentable over Arsenault because that reference does not disclose each and every element recited in the claim.

For reasons similar or somewhat similar to those described above with regard to independent claim 1, independent claims 4, 9 and 11 are also believed to be patentable.

III. REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 7 and 8 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Arsenault in view of PCT International Publication No. WO 92/22983 (PCT Appl. No. PCT/US92/04573) to Browne et al. (hereinafter, merely “Browne”).

Claims 7 and 8 depend from independent claim 4 and should be allowable for at least the same reasons. Browne does not teach or suggest the elements of claim 4 missing from Arsenault, as discussed above.

BROWNE DOES NOT TEACH OR SUGGEST THE ELEMENTS RECITED IN CLAIM 8

Moreover, claim 8 recites, “the time information obtained in the time information extract means is employed as time information of the control means so that the forefront data of the

predetermined area on the hard disk is recorded.” The Office Action asserts Browne discloses the element of claim 8 but then fails to point to any citation in Browne that teaches or suggests the recited element. Thus, claim 8 is patentable over Arsenault and Browne for this additional reason.

NO MOTIVATION TO COMBINE
ARSENAULT AND BROWNE

As discussed by the Court of Appeals for the Federal Circuit, a proper conclusion of obviousness under 35 U.S.C. 103 requires that there be some motivation in the prior art that suggests the claimed invention as a whole:

“[A]n Examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” [Citations omitted] To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show motivation to combine the references that create the case of obviousness.”

In re Rouffet, 149 F.3d 1350, 1357; 47 U.S.P.Q. 2d (BNA) 1453, 1457-1458 (Fed. Cir. 1998).

As further explained by the Federal Circuit:

“Our case law makes clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references.” *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q. 2d (BNA) 1614, 1617 (Fed. Cir. 1999) “Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight.” *Id.*

What is lacking from the combination of the references is a teaching, suggestion or motivation that comes from the references themselves, or from the problem to be solved, to combine the respective teachings to arrive at the Applicant's claimed invention. The locations pointed to in the Office Action do not provide the teaching, suggestion or motivation to combine the references as asserted. The Office Action asserts the motivation to combine Arsenault and Browne is "to limit the cost of a television receiver." This is a vague and unspecific reason that may be applied to most every combination of elements. Further, the Examiner's opinion for combining the references does not take the place of locating a motivation to combine from the references themselves to establish obviousness.

IV. DEPENDENT CLAIMS

The other claims are dependent from one of the claims discussed above and are therefore believed patentable for at least the same reasons. Because each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

CONCLUSION

Claims 1-11 are in condition for allowance. In the event the Examiner disagrees with any of statements appearing above with respect to the disclosure in the cited reference, or references, it is respectfully requested that the Examiner specifically indicate those portions of the reference, or references, providing the basis for a contrary view.

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In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are patentable and Applicants respectfully request early passage to issue of the present application.

Respectfully submitted,

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